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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,420	06/15/2000	MANFRED BERNDT	100/08410	9071

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EXAMINER

BROWN, JENNINE M

ART UNIT	PAPER NUMBER
1743	6

1743

6

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Chow, et al. (US 5989402).

Chow, et al. teach a removable microfluidic device called a "first interface component" or "first physical unit" (10) inserted into an analysis system called "a second physical unit" or "material transport system" (208) spatially separated from the first unit (Figure 2A) where second physical unit (208) provides material transport by controlling voltage through a control unit coupled to the fluid supply system (Figure 1A) whereby fluid and electrical charge are supplied to the microfluidic device through the

bayonets (204) of the second physical unit which are aligned with the wells of the microfluidic device which pierce a gasket and sensor for measuring voltage and/or optical energy within the microfluidic device (col. 17, l. 24-41; col. 4, l. 46-55; col. 7, l. 1-22; col. 18, l. 1 – col. 22, l. 63).

### ***Non-statutory Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this

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rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Claims 1-11 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over claims 1-17 of copending Application No. 09/598,968 which has a common inventor with the instant application. Although the conflicting claims are not identical, they are not patentably distinct from each other because both have been drawn to a System Operating a Microfluidic Chip with a Removable Interface.

Claims 1-12 and 14 in this application, **09/595420**, specify a microfluidic chip and a device for receiving the microfluidic chip, supplying it with electrical power, and methods of fluid movement within the chip. Similarly, Claims 1-11 in application **09/598968** specify a microfluidic chip and a device for receiving the microfluidic chip, supplying it with electrical power, and methods of fluid movement within the chip.

It would have been obvious to one of ordinary skill in the art that the device of application **09/595420** would be considered encompassed by the device and improvements of application **09/598968**.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (703) 305-0435. The examiner can normally be reached on M-F 8:00 AM - 4:30 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

jmb  
April 4, 2002

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700